

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

VISUAL REAL ESTATE, INC.,
Patent Owner

Case IPR2014-01341
Patent 8,078,396 B2

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Visual Real Estate, Inc. (“Patent Owner”) hereby submits the following objections to the evidence served on September 2, 2015 by Petitioner Google Inc. (“Petitioner”) with Petitioner’s Reply to Patent Owner’s Response (“Petitioner’s Reply”).

General Objections

1. Further to the September 9, 2015 telephone conference between the Board and the parties, Patent Owner objects to the Responsive Declaration of Dr. John R. Grindon (Ex. 1012, “Dr. Grindon’s Declaration”) as untimely and prejudicial. From the beginning of this proceeding, Patent Owner has made clear that Dr. Grindon’s testimony would be relevant (*see* Patent Owner’s Preliminary Response, Paper 9 at 15, 24) and specifically asked Petitioner to provide him for a deposition as early as February 23, 2015, well before Patent Owner’s Response was due. At the time the request was made, Dr. Grindon was already a paid consultant of Petitioner who previously offered sworn testimony about the disclosure of a key reference (Ex. 1005) which is inconsistent with Petitioner’s position in this proceeding (*see* Ex. 2002). Petitioner refused to allow Patent Owner to depose Dr. Grindon before Patent Owner filed its Patent Owner Response and as a result, Patent Owner elected not to offer another expert’s testimony beyond Dr. Grindon’s declaration, and the admissions made by Dr. Henry Fuchs, Petitioner’s Original Declarant in this proceeding. *See* Ex. 1001;

Patent Owner's Response, Paper 21 at 9-11 (relying on Dr. Fuchs' admissions). After Patent Owner submitted into evidence Ex. 2002 with its Patent Owner Response, Petitioner made no objection to the exhibit, and it is now in evidence. Petitioner made no request to depose Dr. Grindon to seek to clarify his testimony. Instead, Petitioner now belatedly offers Dr. Grindon's new declaration testimony to "put[] his prior opinions in context" Petitioner's Reply at 2. Petitioner's submission of Dr. Grindon's Declaration at this late stage is improper as untimely and prejudicial since Patent Owner has been deprived of an opportunity to address Dr. Grindon's new testimony in any briefing and expert testimony to the Board.

2. Patent Owner objects to the admissibility of Dr. Grindon's Declaration under Rules 702 and 703 of the Federal Rules of Evidence ("F.R.E.") for failing to establish that he is qualified to provide the opinions offered. Dr. Grindon also fails to provide any basis for many of his opinions. Thus, Dr. Grindon's Declaration is inadmissible as lacking the requisite underlying "sufficient facts or data" of F.R.E. 702(b), is not "the product of reliable principles and methods" under F.R.E. 702(c), and does not result from the reliable application of principles or methods to any related facts under F.R.E. 702(d). *See also Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579 (1993); 37 C.F.R. § 42.65.

3. Patent Owner further objects to the relevance of Dr. Grindon's Declaration under F.R.E. 402. Dr. Grindon's Declaration consists of mere speculation and conclusory statements, which are not relevant.

4. Patent Owner also objects to Dr. Grindon's Declaration under 37 C.F.R. § 42.65. Dr. Grindon's Declaration is based on underlying facts or data, but he does not disclose the underlying fact or data. Accordingly, his testimony is entitled to little or no weight.

5. Patent Owner further objects to Dr. Grindon's Declaration since it offers testimony on elements of Petitioner's *prima facie* case, which are not included in Petitioner's original petition and should have been included as part of Petitioner's *prima facie* case of invalidity, and is therefore untimely and prejudicial.

6. Patent Owner also objects to Dr. Grindon's Declaration under F.R.E. 402 as irrelevant since it is based on a different definition of "a person of ordinary skill in the art" than that proposed by Petitioner's original expert, Dr. Henry Fuchs, which was relied upon by the petition. *Compare, e.g.*, Ex. 1001, ¶ 16, *with* Ex. 1012, ¶¶ 9, 10, 12.

7. Patent Owner also objects to Dr. Grindon's Declaration as incomplete since Paragraph 22 of Dr. Grindon's Declaration indicates that Dr. Grindon has not

completed his analysis or acquired all the necessary information to form his opinion.

8. Patent Owner reserves the right to present further objections, as allowed by the applicable rules or other authority.

Specific Objections

In addition to the foregoing General Objections, Patent Owner makes the following specific objections to Dr. Grindon's Declaration and Petitioner's other exhibits. Since Petitioner's Reply cites to Dr. Grindon's Declaration and the objected to exhibits, these objections also apply to Petitioner's Reply.

1. Patent Owner objects to Paragraphs 15-18 of Dr. Grindon's Declaration as untimely and prejudicial testimony seeking to contradict, "supplement," or "explain" his prior sworn, unobjected to testimony set forth in Ex. 2002.

2. Patent Owner objects to Paragraphs 13, 17, 18 and 20 of Dr. Grindon's Declaration for seeking to offer proof going to establishing a *prima facie* case not set forth in the Corrected Petition or Dr. Fuchs' supporting declaration (Ex. 1001), which Dr. Grindon does not even claim to have reviewed.

3. Patent Owner objects to Paragraph 18 of Dr. Grindon's Declaration under F.R.E. 802 for including inadmissible hearsay about unnamed individuals,

computer systems and processors (e.g., MSI K7N1 motherboard, AMD Athlon XP 3200+ 2GHz processor).

4. Patent Owner also objects to Paragraph 18 of Dr. Grindon's Declaration under F.R.E. 402, 702 and 703 and 37 C.F.R. § 42.65 for containing speculative and conclusory statements regarding the state of art and the operation of various allegedly available computers, chips, and components which are unsupported by any facts or data and thus irrelevant and entitled to little or no weight.

5. Patent Owner objects to Paragraphs 9, 10 and 12 of Dr. Grindon's Declaration under F.R.E. 402 as irrelevant since they are based on a different definition of "a person of ordinary skill in the art" than the one proposed by Petitioner's original expert, Dr. Henry Fuchs, which was relied upon by the petition. *See* Ex. 1001, ¶ 16.

Respectfully submitted,

Dated: September 10, 2015

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on this 10th day of September, 2015, a copy of the foregoing PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(b)(1) was served via e-mail on the counsel of record for the Petitioner at the following e-mail addresses:

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